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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,599	12/05/2001	John K. Thottathil	LD57F	3898

23914 7590 10/27/2003

STEPHEN B. DAVIS  
BRISTOL-MYERS SQUIBB COMPANY  
PATENT DEPARTMENT  
P O BOX 4000  
PRINCETON, NJ 08543-4000

EXAMINER

TRINH, BA K

ART UNIT: PAPER NUMBER

1625

DATE MAILED: 10/27/2003

Y

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/006,599

Applicant(s)

THOTTATHIL ET AL.

Examiner

Ba K. Trinh

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/09/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims 1 to 5, 7-23 is pending. Claims 8-23 are withdrawn from consideration as being drawn to non-elected invention.

Applicant's election with traverse of group I, claims 1 to 5 and 7 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the search for all inventions can be made without serious burden. This is not found persuasive because the taxane derivatives can be made by methods other than the current method, such as, reacting on oxazolidine with baccatin III. The current lactam can be used for anti inflammatory activity as taught by Firestone et al (US 4,680,391) cited by applicants; note the item AK of the IDS the search of the lactam derivatives is not required for the search of taxane derivatives, and vice versa. A reference of the lactam derivatives would not suggest and/or render the taxane derivatives obvious. Thus, restriction required is deemed proper.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holton (US 5,175,315) in view of Greene et al.

Holton teaches a lactam derivative, which is analogous to the claimed lactam; note the abstract. The prior art R<sub>2</sub> group is a hydroxy protecting group such as ethoxy-ethyl or acetyl; note lines 28 to 60 column 12 of the patent, while the current substituent

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is an alkoxy alkyl group (or a hydroxy protecting group). Greene et al teaches a variety of hydroxy protecting group which include the prior art ethoxy ethyl and the current 1-methyl-1-methoxy ethyl; note items 29 and 31 in page 11 of the reference. It would be obvious to modify the lactam of Holton by replacing one hydroxy protecting group with another equivalent hydroxy protecting group as taught by Greene et al to form the current lactam for the same utility of making taxanes.

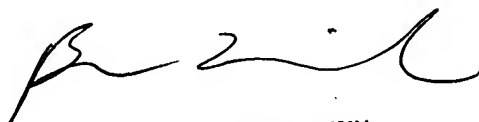
No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is (703) 308-4545. The examiner can normally be reached on Monday-Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Trinh/LR  
October 6, 2003



BA K. TRINH  
PRIMARY EXAMINER  
GROUP 1200 / 625